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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/681,008 | 11/15/2000 | Johann Engelhardt | 102847-28 | 1885 |
| 29127 | 7590 | 11/21/2003 | EXAMINER | |
| HOUSTON ELISEEVA 4 MILITIA DRIVE, SUITE 4 LEXINGTON, MA 02421 | | | FERNANDEZ, KALIMAH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2881 | |

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/681,008 | ENGELHARDT, JOHANN | |
| | Examiner | Art Unit | |
| | Kalimah Fernandez | 2881 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2,4-6, and 8-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,881,045 issued to Inoue and in view of US Pat No 6,275,454 issued to Boutaghou et al.

3. Inoue teaches a specimen (i.e. CD) receiving device for hold a plurality of specimens (i.e. CD) (col. 3, lines 1-20; col.5, lines 29-42).

4. Inoue teaches said specimen receiving device being linearly displaceable via transport mechanism (col.3, lines 16-20; col.9, lines 40-67).

5. Inoue teaches said specimen receiving device being rotatable about the axis of rotation (col.5, lines 50-53).

6. Inoue teaches said scanning device (30) provided for optically scanning the specimen (col. 6, lines 5-7).

7. Further, Inoue teaches the use of a movable scanning device /optical head (col.6, lines 8-17).

8. Inoue does not explicitly teach said scanning device/optical head being linearly displaceable and being rotatable.

9. However, Boutaghou et al teaches a scanning device/ optical head which is both linearly displaceable and rotatable about an axis (16) of rotation (col.3, lines 18-42; see figs. 1-2).

10. It would have been obvious to one of ordinary skill in the art to combine the teachings of Inoue and Boutaghou et al since Boutaghou et al teaches an improved positioning mechanism (col.1, lines 35-44).

11. As per claim 2, Boutaghou et al teaches the specimen receiving device defines a rotation speed of the specimen and the scanning device remains substantially constant during a relative motion between the scanning device and the specimen-receiving device (col.3, lines 18-32).

12. As per claim 4, Boutaghou et al teaches a constant optical distance between a specimen and the scanning device (col.3, lines 29-32).

13. As per claim 5, Boutaghou et al teaches said specimen receiving device defines a rotation speed of the specimen receiving device, and the

rotation speed is dependent on the relative position between the specimen receiving device and the scanning device (col.3, lines 27-32).

14. As claim 6, Boutaghou et al teaches the rotation speed is dependent on a detected data stream of the scanning device (col.3, line 62-col.4, line 5).

15. As per claims 8-12, Inoue teaches a replacable, single vessel/ carousel insert (i.e. cd) on a carriage (col.5, lines 22-41; col.5, lines 42-53).

16. As per claim 13, Boutaghou et al teaches an auto-focusing means (44) maintaining the specimen in focus (col.3, lines 43-51).

17. As per claim 14 and 19-20, Boutaghou et al teaches focusing a specimen. Boutaghou et al does not teach the recited ranges; however, it is held that focal variables are result-effective variable. That is, the selection of the values of the recited focal variable will achieve an art-recognized result.

18. As per claim 15, Boutaghou et al teaches a laser source (58) and a detector (60) (col.3, lines 52-55).

19. As per claim 16, Boutaghou et al teaches said laser beam being scanned /deflected at least one directions (col.2, lines 52-64).

20. As per claim 17, Boutaghou et al teaches said laser beam is stationary relative to the scanning device (20) (col.3, lines 52-66; fig. 3).

21. As per claim 18, Boutaghou et al teaches said laser beam provided for scanning can be of different wavelengths (col.4, lines 16-20). Namely, Boutaghou et al teaches the ability to select different wavelengths depend on the mode of operation; therefore, Boutaghou et al teaches scanning in different wavelengths.

22. As per claim 21, Boutaghou et al teaches said laser beam defines an non-zero incidence angle on the surface of the specimen receiving device (see fig. 2).

23. As per claim 22, Botaghou et al teaches synchronization markers provided on the specimen (col.4, lines 20-22).

Response to Arguments

24. Applicant's arguments filed 8/21/2003 have been fully considered but they are not persuasive. First, applicant contends that the claimed invention is patentable over the obvious combination of Inoue and Boutaghou since the claimed invention is related to optical scanning microscopy while the prior art is related to CD player technology.

25. In response, the recitation “ in a confocal scanning microscope” is merely intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

26. Here, the obvious combination of Inoue and Boutaghou satisfies the structural limitations of the recited optical scanning apparatus. The fact that Inoue and Boutaghou are employed in a CD player rather than a confocal scanning microscope does not distinguish the claimed invention such that it would be deemed patentable.

27. Second, applicant asserts, “Inoue does not disclose a specimen receiving device for holding a plurality of specimens.” Applicant presumably relies on the claim language “a specimen receiving device for holding a plurality of specimens” to support this assertion. It is pointed out that Inoue teaches a specimen-receiving device (200) capable of receiving up to 15 specimens (i.e. CD) (col.5, lines 29-41).

28. In addition, the claim language neither requires scanning a plurality of specimens at the same time nor prohibits apparatuses that hold a plurality

of specimens and scan each specimen when the operator desires as in Inoue.

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalimah Fernandez whose

Application/Control Number: 09/681,008
Art Unit: 2881

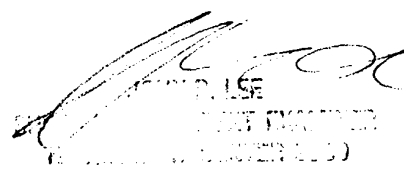
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telephone number is 703-305-6310. The examiner can normally be reached on Mon-Thurs between 7:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 703-308-4116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

kf


JOHN R. LEE
SUPERVISOR
(703) 308-4116